REMARKS

This Application has been carefully reviewed in light of the final Office Action mailed October 18, 2004 (the "Office Action"). Claims 1-27 are pending in the application. In the final Office Action, Claims 1-27 were rejected. For at least the reasons discussed below, Applicants respectfully request reconsideration and favorable action in this case.

Section 103 Rejections

The Office Action rejects Claims 1-27 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,529,599 to Gorshe ("*Gorshe*") in view of U.S. Patent No. 6,332,198 to Simon et al. (*"Simon"*). Applicants respectfully traverse all rejections therein.

According to M.P.E.P. §2143, to establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation to combine the references. Second, there must be a reasonable expectation of success. Third, the prior art combination of references must teach or suggest all the claim limitations.

Applicants submit that at least the third criteria necessary to establish a *prima facie* case of nonobviousness has not been met, because the relied upon *Gorshe-Simon* combination fails to teach, suggest, or disclose each and every element of the claimed invention. For example, amended Independent Claim 1 recites, "determining a higher priority item between the first and second equipment items based on the first and second equipment types." In the Examiner's present Office Action, the Examiner acknowledges that *Gorshe* does not disclose, teach, or suggest first and second equipment types. (Office Action, page 2). The Examiner instead relies upon *Simons* for disclosure of these features.

However, *Simons* does not make up for the acknowledged deficiencies of *Gorshe*. To the contrary, *Simons* merely discloses "a method and apparatus for supporting multiple redundancy schemes in a single network device." (Abstract). Specifically, *Simons* provides that "[i]n one network device, various redundancy schemes are supported including 1:1, 1+1, 1:N, no redundancy or a combination of redundancy schemes." (Abstract). Thus, each element within a network device is assigned to a redundancy scheme. With regard to the assignment of redundancy schemes, *Simons* specifically states that "the redundancy scheme or schemes for the universal port cards (or ports) may be the same as or different from the

redundancy scheme or schemes for the forwarding cards." (Column 3, lines 2-5). Accordingly, *Simons* indicates that different redundancy schemes may be assigned to like elements and that the same redundancy scheme may be assigned to different-types of elements. This is necessarily contrary to "determining a higher priority item . . . based on the first and second equipment types," as recited in Applicants' Claim 1.

As further support of the deficiencies of *Simons*, *Simons* provides examples illustrating the assignment of redundancy schemes. In an example used repeatedly in *Simons*, *Simons* discloses that "the network manager may provide certain customers with 1:1 or 1+1 redundancy on both the universal port cards (or ports) and forwarding cards to ensure that customer's network availability while providing other customers, with lower availability requirements, with various other combinations of redundancy schemes." (Column 3, lines 8-13). Thus, *Simons* explicitly states that priority is based upon the customer rather than an equipment type. Furthermore, because the same redundancy scheme may be assigned to both universal port cards and forwarding cards, *Simons* does not disclose, teach, or suggest "determining a higher priority item . . . based on the first and second equipment types," as recited in Applicants' Claim 1.

Furthermore, *Simons* does not even disclose an equipment type that could be used to determine a higher priority item. The Examiner points to the logical identifier disclosed in *Simons* as being the equivalent of Applicants' equipment type. However, with respect to the logical identifier, *Simons* discloses that "[t]he network device may further include a logical identifier to physical identifier card table including records for identifying the first and second redundancy schemes." (Column 4, lines 10-12). Thus, the logical identifier of *Simons* is merely used to identify the particular redundancy scheme (i.e., 1:1, 1+1, 1:N, no redundancy or a combination of redundancy schemes) assigned to an element of the network device. Accordingly, Applicants respectfully submit that the logical identifier disclosed in *Simons* is not the equivalent of Applicants' claimed equipment types.

Finally, Applicants note that the *Simons* network device is manually pre-configured to assign particular redundancy schemes to particular elements. Specifically, *Simons* discloses that "network managers [are provided] with maximum flexibility in choosing redundancy schemes for their network devices." (Column 2, lines 51-53). Accordingly, a "work station

62 is coupled to many network computer systems and [network management system (NMS)] 60 is used to configure and manage each of these systems.   (Column 14, lines 46-48). "The NMS informs the user of the hardware available in computer system 10. This information may be provided as a text list, as a logical picture in a graphical user interface (GUI), or in a variety of other formats. The user then tells the NMS how they want the system configured." (Column 16, lines 51-55).   Accordingly, *Simons* is limited to a system that allows a network manager to pre-configure the elements of a network device. *Simons* does not disclose a system that performs automatic prioritization after receiving a prioritization request.

For at least these reasons, Applicants respectfully request reconsideration and allowance of Claim 1, together with Claims 2-12 that depend from Claim 1.

Independent Claim 13 recites, "evaluating a priority of the request based on . . . the equipment type relative to all other outstanding protection requests for equipment items in a protection group with the equipment item."   Accordingly, for reasons similar to those discussed above with regard to Claim 1, Applicants respectfully submit that neither *Gorshe* nor *Simons*, whether considered alone or in combination, discloses each and every element of Applicants' Claim 13.

As a further example, Claim 13 also recites "evaluating a priority of the request based on the request type . . . " Thus, the claim clearly recites evaluating the priority based on the request type *and* the equipment type. With regard to the request type, the Examiner states that "applicant broadly claims a priority type" and interprets "a priority type as the request which inherently carries value or type or priority." (Office Action, page 7).   However, Applicants' Claim 13 does not include a recitation of a priority type. Rather, Applicants' Claim 13 recites both an equipment type and a request type.   To the extent that the Examiner has mischaracterized Applicants' Claim 13, Applicants respectfully object to any such micharacterization.

Furthermore, the Examiner relies upon inherency to reject Applicants' claimed "request type." (Office Action, page 7). "To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain

thing may result from a given set of circumstances is not sufficient." M.P.E.P. § 2112; *See In re Robertson*, 49 U.S.P.Q.2d 1949, 1150-51 (Fed. Cir. 1999). "In relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic <u>necessarily</u> flows from the teachings of the applied prior art." M.P.E.P. § 2112; *Ex parte Levy*, 17 U.S.P.Q. 1461, 1464 (Bd. Pat. App. & Inter. 1990). In rejecting Claim 13, the Examiner has not provided a basis to reasonably support the Examiner's determination that Applicants' claimed request type is inherent from the teachings of *Gorshe*. In fact, it remains Applicants' position that *Gorshe* fails to teach or suggest evaluating a priority of the request based on the request type. Applicants further submit that the claimed request type is not inherent from the disclosure of *Gorshe*. As discussed in Applicant's previous Response to Office Action, *Gorshe* merely discloses prioritizing working units' access to a protection bus based on the extent that their failures affect the network,[1] which is *not based on a request type* as claimed in the Application. Furthermore, for the reasons stated above, the *Gorshe-Simons* combination fails to teach or suggest determining a priority of a request based on *both* a request type and an equipment type. Accordingly, Applicants submit that Claim 13 and its dependents are patentability distinct from *Gorshe*, *Simons*, and their combination.

For at least these reasons, Applicants respectfully request reconsideration and allowance of Claim 13, together with Claims 14-15 that depend from Claim 13.

Independent Claims 18, 23, and 27 recite limitations that are similar, although not identical, to the limitations of Claim 13 discussed above. Therefore, these claims are allowable for reasons analogous to those discussed above in connection with Claim 13. Claims 19-22 and 24-26 depend from independent Claims 18 and 23, respectively, and are thus also patentable over the cited art.
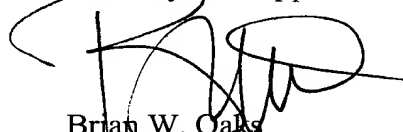
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[1] Col. 7, Lines 9-23.

CONCLUSIONS

Applicants have made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request full allowance of all pending claims.

If the present application is not allowed and/or if one or more of the rejections is maintained, Applicants hereby request a telephone conference with the Examiner and further request that the Examiner contact the undersigned attorney to schedule the telephone conference.

Although no fees are believed to be due, the Commissioner is hereby authorized to charge any fees to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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